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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,740	11/20/2001	Pekka Juhana Pihlaja	04770.00028	8949

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BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/988,740

Applicant(s)

PIHLAJA, PEKKA JUHANA

Examiner

HENRY N. TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28,30,32,33,36-45,49-51,53-62 and 69-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 44 is/are allowed.
- 6) ☒ Claim(s) 1-10,13-16,18,22,23,25,27,30,32,33,36-42,45,49-51,53-62,69 and 73-75 is/are rejected.
- 7) ☐ Claim(s) 11,12,17,19-21,24,26 and 70-72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The Amendment received January 21, 2005 has been fully considered; and this Office action is in response thereto.

#### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The newly added claim term: “a selection element” recited in the amended independent claims 28 and 30 has no clear support in the Specification. The applicant is required to amend the Specification for providing a clear written description for the claimed phrase “moving a selection element over corresponding content displayed on the display screen”; particularly, the term “a selection element”.

For the purpose of this Office action, the examiner assumes that “a selection element” is broadly interpreted as a display element, such as a pointer, or a cursor, or an icon (or an item) displayed on the display screen.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 28, 36-39, and 74 stand rejected under 35 U.S.C. 102(b) as being anticipated by Armstrong et al (U.S. Patent No. 5,729,219, hereinafter referred to as "Armstrong") as recited in the prior Office action mailed 11/22/04.

4. Claims 28, 30, 36-40, 59-62, 74, and 75 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hayes, Jr. et al (U.S. Patent No. 6,131,047, hereinafter referred to "Hayes, Jr.") as recited in the prior Office action.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-10, 13-16, 18, 22, 23, 25, 27, 32, 33, 41, 42, 45, 49-51, 53-58, 69, 73, and 75 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes, Jr. in view of Armstrong as recited in the prior Office action.

***Allowable Subject Matter***

7. Claims 43 and 44 allowed.

8. Claims 11, 12, 17, 19-21, 24, 26, and 70-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments provided in pages 13-17 of the above-identified Amendment have been fully considered but they are not persuasive because of the following reasons:

(i) Applicant argued that the Office action rejection is non-responsive and deficient because fails to address the Applicant's previous arguments set forth in the Amendment filed May 10, 2004

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and also fails to address the claim phrase: “wherein the first touch-sensitive input area is resistant to sound interference,” recited in claim 28. The examiner disagrees because: firstly, said Applicant’s arguments have been considered, and are moot in view of the new grounds of rejection recited in the prior Office action as specifically said in paragraph 11 of the Office action mailed 8/9/04; and secondly, said claim phrase has been addressed in paragraph 6 of the prior Office action. It’s also noted that the language of claim 28 does not specifically define how the first touch-sensitive input sensor area is resistant to sound interference; and therefore Armstrong touchpad 22, or Hayes planar touch sensitive input sensor strips 150a-c are read on said claimed limitation because Armstrong touchpad or Hayes planar touch sensitive input sensor strips are made of materials, and all the materials are more or less resistance to sound interference that is a basic knowledge in the science of materials. Claims 28, 36-39, and 75 are therefore stand rejected.

(ii) Applicant also argued that the Hayes reference fails to teach: “wherein the first planar touch-sensitive input ~~sensor~~ area is resistant to sound interference, said first planar touch-sensitive input ~~sensor~~ area comprising a touch pad ...” as recited in claim 28; also, the Office action refers the Hayes plurality of keys 130 are a planar touch-sensitive input area comprising a touchpad; further also, Hayes touch sensitive input area comprising a touchpad provides no sound resistance; Note: the strikethrough or underlined words showed above are in the language of the newly amended claims. The examiner disagrees because the Office action does not recite that Hayes keys 130 are a planar touch-sensitive input area comprising a touchpad as read by the applicant; in fact, Hayes input device comprising keys 130 and touch-sensitive strips, such as keys and a touchpad 150c as illustrated in fig. 11, are used to read on said claim feature; further,

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the sound resistance capability of the touch input devices is inherently provided by the materials used to make them up as discussed in the Office action, and further explained above, see (i).

Claims 28, 30, 36-40, 59-62, 74, and 75 are therefore stand rejected;

(iii) Applicant further also argued that the Hayes reference fails to teach the claim feature of claim 40: "a touch-sensitive sound resistant planar input device covering a first face of the casing, wherein the planar input device comprises at least one hole through which sound emitted from the speaker passes."; and sound can not pass through the planar input device because there are no holes in the keys 130 of Hayes. The examiner disagrees because Hayes teaches a planar input device comprising a casing 110, a speaker housed within the casing and having holes arranged with a planar input device covering the front face of the casing for emitting sound (see fig. 3 or 11). Clearly, holes in the keys 130 as suggested by applicant are unneeded.

(iv) In response to applicant's argument that there is no suggestion to combine the references of Hays and Armstrong; and the combination is based on hindsight. First, The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hayes reference and Armstrong reference are both directed to portable electronic devices and methods for controlling information displayed on a display screen of the portable electronic device; wherein, Hayes utilizes linear input devices, which are keypad with keys 130 and touchpads or sensitive strips 150a-c and speaker with holes arranged on surfaces of the housing 110; and Armstrong utilizes

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touchpad 22 arranged on the back face 16 of the housing; therefore, one of ordinary skill in the art would have been motivated to combine the teachings of Hayes and Armstrong for providing improved portable electronic devices, which provide reliable, intuitive and efficient display control, and are easily and effectively to use. Second, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(v) Finally, Applicant argued that “Even if Improperly Combined, the Claims are Not Taught by the Combination” because: Hayes only uses three input devices, not four; Hayes and Armstrong does not teach a control logic for “enlarge or reduce”, or “panning”, or “altering the size of an image”, etc. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to the claim features such as a control logic for “enlarge or reduce”, or “panning”, or “altering the size of an image”, etc. It's noted that Hayes does teach: a controller 220 for editing functions, such as “selection of items displayed on the display” and “perform display movements” (see col. 2, lines 24-28), and “highlighting displayed graphical objects” (col. 2, lines 63-64), and “scrolling displayed rows” (col. 3, line 18); and Armstrong does teach: “a controller typically comprises a

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microprocessor having and software” for editing functions, such as “navigating within GUI including selectively viewing messages on the display” (see col. 4, lines 40-42), and “highlighting the selected items (see col. 5, lines 3-10), etc. It’s obvious to one of a person skilled in the computer display GUI art for modifying the editing functions as taught by Hayes and Armstrong to include other editing functions such as: “enlarge or reduce”, or “panning”, or “altering the size of an image”, as suggested in the prior Office action. By this rationale, claims 1-10, 13-16, 18, 22, 23, 25, 27, 32, 33, 41, 42, 45, 49-51, 53-58, 69, 73, and 75 stand rejected.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

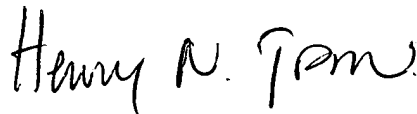
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK N. EDOUARD can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Henry N. Tran". The signature is fluid and cursive, with the first name "Henry" and last name "Tran" clearly distinguishable.

HENRY N TRAN  
Primary Examiner  
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6/10/05